

REMARKS

The Office action and the Examiner's comments have been seriously and carefully considered. Applicant is amending claim 1 and 47 to include recitations in claims 2, 20, 28 and 31. Claim 2 is being cancelled and claims 1, 3, 4, 11, 12, 20, 31 and 42 are being amended to reflect cancellation of claim 2. Each of claims 8, 9, and 10, as currently amended depends from claim 1. No new matter is being added. Therefore, Applicant respectfully requests entry of the amendments.

Claims 1-42 and 47-51 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent Application No. 10/790,280 ("'280 Application") in view of U.S. Patent Application Publication 2002/0128414 A1 ("*James*"). The position taken by the Patent Office is that the instantly claimed invention "overlaps" with the subject matter claimed in the '280 Application in that the latter is directed toward a "personal care product" comprising at least one EPOSS having a rigid, three dimensional caged structure comprising 9 or more Si atoms within its cage structure. The Office acknowledges that unlike the instantly claimed invention, the '280 Application does not disclose a cage structure comprising between 6 to 8 Si atoms within its cage structure. In an attempt to address this difference, the Office has relied upon *James*, which is alleged to disclose a general rigid three dimensional cage structure of a silsesquioxane-based monomeric unit with 8 Si atoms within the cage structure, wherein all of the cage Si atoms are completely saturated and all of said Si atoms are bound to at least 1 other Si atom within the said cage structure through an oxygen atom and wherein the cage structure has at least 2 completed sides, wherein each of said Si atoms being bound to at least 1 R group with no more than 1 said Si atoms being bound to more than 2 R groups, said POSS being present in an amount preferably at 20-85

weight percent (wt%) in a monomeric mixture, where each R is independently selected from a group consisting of a C1-C12 monovalent hydrocarbon radical, a C1-C12 monovalent hydrocarbon radical containing ether linkages, a halogen-substituted C1-C12 monovalent hydrocarbon radical, and a halogen-substituted C1-C12 monovalent hydrocarbon radical containing ether linkages, and in particular, POSS where R is cyclopentyl or isobutyl, which overlaps with the instantly claimed invention. The Office also alleges that *James* also teaches copolymers prepared from a monomeric mixture comprising a) an itaconate ester at about 0 to about 60wt%, preferably about 20 to about 55 wt%, and b) a POSS compound of instant structure I at about 3 to 85 wt%, preferably about 5 to about 60 wt%, and more preferably about 10 to about 25wt%. The Office further alleges that *James* discloses that the POSS compounds useful as monomers in accordance with the invention can be produced by general methods known in the art. The Office has determined that someone of skill in the art, at the time the instantly claimed invention was made would have found it obvious to create the instantly claimed invention with a reasonable expectation of success in view of the '280 Application and in view of *James*.

The rejection as it applies to claim 2 is now moot. Applicant respectfully traverses the rejection as it applies to the remaining claims because the collective teachings of the two cited publications do not establish *prima facie* obviousness.

The text of the rejection is merely directed to factual allegations regarding the scope and content of the prior art. Implicit in the determination reached by the Office is that a person of ordinary skill in the cosmetics art would have been motivated to substitute the POSS compounds used in *James*'s ophthalmic lenses in exchange for the EPOSS compounds in the cosmetic compositions disclosed in the '280 Application. Absent from the text of the Office action, however, is any evidence or

reasoning as to why a person of ordinary skill in the art would have been motivated to modify the cosmetic compositions disclosed in the '280 Application by substituting the POSS-containing copolymers in *James's* ophthalmic lenses for the EPOSS compounds. Thus, even if "overlap" between *James's* POSS compounds and the POSS compounds recited in the present claims actually exists, the cited prior art does not establish a case of *prima facie* obviousness. Reconsideration and withdrawal of the provisional rejection are respectfully requested.

Claims 1, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20 and 21 have been rejected under 35 U.S.C. § 102(b) as anticipated by *James*. Applicant respectfully submits that the instantly claimed invention as amended is not anticipated by *James*.

There is no disclosure in *James* of a sunscreen composition, suntan product, antiperspirant, deodorant, cold cream, moisturizer, cleaner, shampoo, conditioner, dual shampoo/conditioner, rinse, cream rinse, cosmetic, hair coloring, hair dye, bleaching composition, styling product, cleansing cream, soap, perfume and cologne, powder, permanent waving product, relaxer, preshave, shaving cream, shaving product, after shaving product, bath product, self tanning product, bleaching product or hair shine product. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-42 and 47-51 have been rejected under § 103(a) as being unpatentable over *James* in view of U.S. Patent 5,804,173 ("*Hutchins*"). The Office has alleged that *Hutchins* teaches personal care compositions comprising a copolymer complex and a volatile hydrophobic solvent component for solubilizing or dispersing the copolymer complex, and that the copolymer complex is formed by complexing a fatty acid with a copolymer, wherein the copolymer comprises a hydrophobic monomer, a hydrophilic monomer such that at least 1% by wt of

the total copolymer, comprises hydrophilic monomers bearing nitrogen functional groups, and optionally a hydrophobic macromonomer, and further that the compositions provide improved delivery, deposition and retention to the hair and skin, and even further that the copolymers can be formulated into a wide variety of product types, including mousses, gels, lotions, creams, ointments, tonics, sprays, aerosols, shampoos, conditioners, rinses, bar soaps, hand and body lotions, mascaras, antiperspirants, deodorants and the like. The Office has determined that in view of the teachings of *Hutchins* that the compositions provide improved delivery, deposition and retention to the hair and skin, someone of skill in the art would have been motivated at the time that the instant invention was created to combine the teachings of *James* and *Hutchins*, such that it would have been obvious for someone skilled in the art at the time that the instant invention was made to create the instant invention with a reasonable expectation of success.

The rejection is moot with respect to claim 2. Applicant respectfully traverses the rejection as it applies to the other claims because the cited prior art does not establish *prima facie* obviousness. Even if the teachings of the cited publications were considered collectively, the presently claimed invention would still not be produced.

The two cited publications have been combined solely by the exercise of impermissible hindsight reconstruction of the claimed invention. The *James* publication is directed to non-analogous technology, namely ophthalmic lenses such as contact lenses. The POSS compounds are disclosed in *James* as constituting one of three different monomeric units of copolymers which make up the lenses. As disclosed in paragraph [0010] in *James*, the copolymers contain two other monomers, namely a) a monomer selected from the group consisting of itaconates, (meth) acrylates, fumarates and styrenes, and (b) an ethylenically unsaturated organosiloxane monomer. The disclosure in paragraph [0031] is that these copolymer materials are "particularly useful as rigid, gas permeable, contact lens

materials due to their improved toughness, oxygen permeability and flexure resistance." Given these collective properties of the disclosed POSS-containing copolymers, Applicant submits that a person skilled in the art would not have been motivated to use the copolymers in any of the personal care formulations such as those disclosed in *Hutchins*, with any realistic expectation that the resultant composition would actually be able to function as a personal care composition. Contrary to the allegations in the Office action, the teachings of the present specification taken with the prior art, including the very art cited by the Office, e.g., *Hutchins* which utilizes the exact terminology, clearly demonstrates that personal care compositions are quite different from ophthalmic lenses.

Aside from that, persons skilled in the art would not have been motivated to introduce *James's* POSS monomer, *per se*, into any of the cosmetic compositions disclosed in *Hutchins*. Prior art publications must be evaluated in their entirety. Thus, it is impermissible to pick and choose within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. See, *In re Mercer* 515, F.2d 1161, 1165-66, 185 U.S.P.Q. 774, 778 (C.C.P.A. 1975). In this case, aside from the non-analogousness of the technology disclosed in the *James* publication, a person skilled in the art would not even have been motivated to the POSS monomers into a cosmetic formulation disclosed in *Hutchins*. For instance, there is no disclosure in *James* that the POSS monomers alone possess any property that would be desirable in a personal care product or cosmetic composition. In addition, the skilled artisan would not have been motivated to "break down" the polymer and use any of its constituent monomers alone, for use of the copolymer in crafting

the lenses is the very essence of the invention disclosed in *James*.

In view of the foregoing, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-42 and 47-51 have been rejected under § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention. The Office has taken the position that although specific chemicals disclosed in the specification do meet the written description and enablement provisions of § 112, first paragraph, claims 1-42 and 47-51 are directed to encompass chemicals of general formulas which only correspond in some undefined way to specifically instantly disclosed chemicals, and that none of these compounds meet the written provision of § 112, first paragraph, due to lacking chemical structural information for what they are, and that the chemical structures are highly variant and encompass a myriad of possibilities. The Office alleges that the compounds encompassed by the claims are only described in general terms and that no structure/function information is disclosed to reasonably correlate a specific compound with its substantivity property or the intended personal care effect to be achieved in practicing the instantly claimed invention. Lastly, the Office alleges that the species specifically disclosed are not representative of the genus because the genus is "highly variant." The rejection is moot with respect to claim 2. Applicant respectfully traverses the rejection as it applies to the other claims.

In citing the *Vas-Cath* decision, the Office emphasizes that this objection is based on an alleged lack of written description, as opposed to enablement. In this case, the present specification does in fact describe the invention particularly with regard to the POSS compounds, in sufficient detail to allow a person skilled in the art of personal care products that the inventor did have possession of the claimed

invention. More specifically, the present claims describe the POSS molecules in terms of basic structures or formulas and representative substituent groups, and in the context of various personal care formulations so as to clearly convey their suitability in connection with these compositions. Although the claims allow for variability in connection with non-recited substituent groups, contrary to the allegations set forth in the Office action, the present specification, e.g., Paragraphs [0008-0010] and [0023-0028], provide structural and functional information that do indeed correlate specific compounds with substantivity properties or intended personal care effects. Thus, in sharp contrast to the fact situations in the *Fiers*, *Amgen*, and the *Eli Lilly* decisions cited in the Office action (in which the specifications of the patents at issue either contained absolutely no structural information regarding the claimed subject matter, or in the *Lilly* case, disclosed only one species of a genus of claimed cDNA molecules), the present specification contains ample guidance with respect to the POSS compounds recited in the present claims. In addition to the several POSS compounds specifically disclosed in the specification, one skilled in the art could immediately envision many, many other such POSS compounds embraced by the claims in view of the description in the specification, e.g., in the aforementioned paragraphs, regarding the various substituent R groups, and the prior art publications referenced therein. Indeed, to be more complete with respect to the state of the law as it regards written description, more recent cases decided by the Federal Circuit reiterate that that there is no requirement to provide a re-description of what was already known in the art. See, e.g., *Capon v. Eshhar*, 418 F.3d 1349, 1356 (Fed Cir. 2005) (ruling that chimeric genes prepared from known DNA sequences of known function need not be analyzed and reported in the specification); *Falko-Funter Falkner v. Inglis*, 448 F.3d 1357 (Fed. Cir. 2006) (holding that the written

description requirement does not require recitation of known genes or sequences).

In view of the foregoing, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-42 and 47-51 have been rejected under § 112, 2<sup>nd</sup> paragraph, as indefinite on various grounds. The rejection with respect to claim 2 is now moot. In response to the rejection as it applies to the other claims, Applicants have amended claims 1 and 47 to recite the full name of "POSS", and have amended claims 8, 9, and 10 to make them depend from claim 1. In view of these amendments, Applicant respectfully submits that all grounds of rejection have been adequately addressed. Reconsideration and withdrawal of the rejection are therefore requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 29, 2007

Respectfully submitted,

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